

this having been the format submitted to the patent office in not only all the issued application, but in all those applications still pending. If a valid MPEP section can be specified wherein Applicant's counsel can be directed for guidance, not only at present but in the future, Applicant will be more than happy to make the suggested change in placing line 19 of page 7 as line 1 of page 8, but only as relates to this application, since such format used by applicant's counsel has never met with objection prior to this application and will likely not meet with said objection with any other Examiner.

As to Paragraphs 2-4, Examiner is entirely correct in his rejections of Claims 2 and 3 based upon 35 USC § 112, and amendments have been made to Claims 2-3 in accordance with the Examiner's rejections.

The rejections to Claims 1-5, as specified in the Office Action are noted, all based upon 35 USC § 103(a). Claims 1-3 is rejected based upon Troutman in view of Fish. Claim 4 is rejected based upon Troutman in view of Fish in further view of Armstrong. Claim 5 is rejected based upon Troutman in view of Fish, in further view of Barnawell. Applicant respectfully disagrees with Examiner as to the propriety of these rejections based upon this prior art and that the Claims should be allowed.

The following section standard and subsequent case law standards must be met in order for the rejections based upon 35 USC §103(a) to stand.

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claim combination and the reasonable expectation of its success must both be found in the prior art, and not based on the applicant's disclosure." MPEP § 2142.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *In Re Geiger*, 815 F.2d 686, 2 U.S.P.Q. 2d 1276 (C.A.F.C. 1987); *In Re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 (C.A.F.C. 1988). Both the suggestion to make the claimed composition or device or carry out the claimed process and the reasonable expectation of success must be founded in the prior art. *In Re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (C.A.F.C. 1991). The art upon which the rejections are based do not fulfill this requirement and are clearly distinguishable.

References cannot be combined arbitrarily and there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin* 170 USPQ 209 (CCPA 1971).

In claims 1-5, an essential disclosed feature is mentioned in each claim. Claim 1 states, in lines 6-10,

“said cross support member having an upper surface containing an upper receiver aperture; a mounting bracket removably attached to said cross support member, said mounting bracket having a pedestal mounting block with an inner threaded bore oriented over said receiver aperture of said cross support member; an outer threaded neck of a pedestal engaging said inner threaded bore...”

Claim 2 further defines this common claim essential feature on page 10, lines 2-5,

“wherein said pedestal is rotated within said inner threaded bore extending or lowering said pedestal, with said upper received aperture allowing for protrusion of said lower end of said pedestal into said cross support member.”

Claims 3-5 also reference this essential feature, which allows the pedestal to be lowered into the cross member and not limit the lowered distance to an upper surface of the cross member. None of the prior art patents discloses this nor do they even contemplate this claimed feature. The specification further highlights this matter, more so than do the claims.

It is fundamental that claims are to be construed in the light of the specification and both are to be read with a view to ascertain the invention. *Transitron Electronic Corp. v. Hughes Aircraft Co.*, 487 F. Supp. 855, 205 USPQ 799 (1980, DC Mass.). As to the particular vernacular of the claims of the invention, the phraseology employed in the claims is the “guiding star” in the construction of the patent. *Super Products Corp. v. D P Way Corp.*, 546 F2d. 748, 756, 192 USPQ 417, 423-424 (1976, CA7 Wis.). There is nothing wrong in defining something by what it does rather than by what it is. *ReEcherd*, 471 F2d. 632, 176 USPQ 321 (1973, CCPA); *Re Swinehart*, 439 F2d. 210, 169 USPQ 226 (1971, CCPA); *Re Fuetterer*, 319 F2d. 259, 138 USPQ 217 91963, CCPA).

The Fish patent does not bear relevancy to the H-shaped base member of the present invention, which is not claimed as such in the applicant’s disclosure. The claims define what appears to be an support base (which might resemble the letter H, as indicated in the drawings) in Claim 1 which is attached, and in the subsequent claims, the base frame being removably attached with suggested bolts and nuts. Indeed, sh patent is a frame member for straightening an automobile frame. It sits upon a base member 23, and even sits on a jack stand with an adjustable height neck. However, the jack stand does not set upon the H-shaped member. Prior art references must either be in the field of Applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the Applicant was concerned, in order to be relied upon as a basis for the rejection of the claimed invention. *In re Oetiker*, 997 F.2d 1443, 24 USPQ2d 1443 (Fed.Cir. 1992).

“Obvious to try” is not a valid test of patentability, and in the present case, it would not be obvious to try Fish to accomplish the task or method disclosed in the current invention. *See, In Re Mercier*, 515 F.2d 1161, 185 U.S.P.Q. 774 (C.C.P.A. 1975).

As to the rejections of Claims 4-5, again there is no reference to the L or T shaped side plates or brackets disclosed in Armstrong or Barnawell securing the pedestal mounting block over “said upper receiver aperture of the cross support member” which extrapolates to the disclosed limitation of base Claim 3 “...with said upper received aperture allowing for protrusion of said lower end of said pedestal into said cross support member.”

There must be a suggestion or teaching that the claimed novel form of the prior art could or should be used. *See, In Re Cofer*, 354 F. 2d 664, 148 U.S.P.Q. 268 (C.C.P.A. 1966). There must be a “reasonable expectation of success” specified in the prior art usage in the current art. *Fritsch v. Lin*, 21 U.S.P.Q.2d 1739 (B.P.A.I. 1991).

The references combined do not disclose the present motorcycle support stand as contained in the claims of the present invention. Therefore, withdrawal of the rejections are appropriate and Applicant respectfully requests that the claims as amended below are allowed to proceed to issue.

The above amendments to Claims add no new matter to the invention and are made to be place in conformity with the rejections of the Examiner in the Office Action.

### CONCLUSION

The applicant submits that the above-noted amendments and remarks put the application in condition for allowance. Applicant therefore respectfully requests that the Examiner withdraw the outstanding objections and rejections contained in the Office Action of 09/21/2005, and pass this application to issue. Applicant expresses their appreciation to the Examiner for Examiners attention and courtesy.

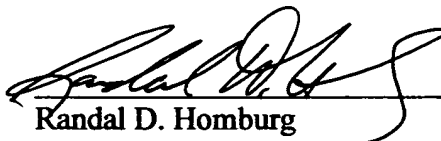
Respectfully submitted;



Randal D. Homburg  
Registration No. 41,847  
P.O. Box 10470  
Midwest City, OK 73140-1470  
Phone: (405) 769-9281  
FAX: (405) 769-9288  
E-mail: [rhomburg@cox.net](mailto:rhomburg@cox.net)

### Certificate of Mailing

This is to certify that on the 14th day of October, 2005, the attached and foregoing documents with an appropriate fee, if any, were mailed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, postage pre-paid, through the United States mails.



Randal D. Homburg